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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

MAILED

Application Number: 09/707,541
Filing Date: November 06, 2000
Appellant(s): SHAPIRA ET AL.

JUL 26 2007

GROUP 3600

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 02/15/2007 appealing from the Office action mailed 09/26/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

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"WebSideStory Introduces StatMarket eData Mining -- the Most Powerful Tool Available for Gathering E-commerce knowledge." Business Wire. New York: September 21, 1999. ("Business Wire")

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Papierniak in view of Business Wire.

Re Claim 1: Papierniak et al. discloses:

A method for tracking and reporting electronic commerce activity over a web site comprising:

storing a web page on a first server (308) coupled to a wide area network, said web page including data fields reflecting commerce transaction activity and data mining code; accepting commerce information within the data fields of the web page at the visitor computer to form a completed web page (306; col.3, lines 13-53).,

receiving the technical and commercial data at a second server (method steps of figs. 8-15, col 1.3, line 22-col 5, line 58).

Papierniak does not explicitly disclose the steps of:

operating the data mining code on the visitor computer to obtain technical and commercial data, and

uploading the web page including the data fields and data mining code to a visitor computer responsive to a request over the wide area network from the visitor computer.

Editors provides a teaching where invisible data mining code is placed on monitored web pages in order to track commerce information for customers (Page 2, "After some invisible code is placed on monitored pages."). It is further well known in the art for web pages to be uploaded to the customer upon a request and therefore the page along with the invisible code is uploaded to the customer (See Editors Page 2, "counts a page view when the page is loaded into an actual Web Browser."). Editors teaches that it was known in the art to utilize code, operating on the customer computer to extract commerce information. This is the same type of commerce information collected in server side applications such as the one described in Papierniak and represents a recognized alternative. It would have been obvious to a

person of ordinary skill in the art to apply the teachings of Editors to the disclosure of Papierniak to allow the data mining to be done on the client side as well as the server side. The ultimate information collected is the same and therefore where the data is collected represents a design choice between the known methods of client side or server side. One would be motivated to use the client side; web based application because it eliminates much of the extensive hardware and software purchases and maintenance.

Re Claim 2: Papierniak further discloses receiving the completed web page at the fast server (col.2, line 57-col.3, line 65); generating an order confirmation web page incorporating the commerce information from the data fields of the completed web page, said order confirmation web page including the data mining code; and uploading the order confirmation web page to the visitor computer (method steps of figs. 8-15; col.3, line 22-co1.5, line 58).

Re Claim 3: Papierniak further discloses The method for tracking and reporting electronic commerce activity of claim 2, further including the steps of associating variables within the data mining code to the commerce information within the order confirmation page; confirming the commerce information at the visitor computer', receiving the order confirmation page from the visitor computer at the first server responsive to the step of confirming the commerce

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information; and receiving the associated variables at the second server responsive to the step of confirming the commerce information (col.3, line 63-col.4, line 10).

Re Claim 4: Papierniak further discloses the step of associating variables includes the steps of associating a variable with a product name of the commercial transaction (co1.3, line 63-co1.4, line 10).

Re Claim 5: Papierniak further discloses the step of associating variables includes the steps of associating a variable with a product category of the commercial transaction (co1.16, lines 36-37).

Re Claim 6: Papierniak further discloses the step of associating variables includes the steps of associating a variable with a number of products purchased in the commercial transaction (co1.15, lines 11-col .17, line 38).

Re Claim 7: Papierniak further discloses the step of associating variables includes the steps of associating a variable with a unit price of the commercial transaction (co1.15, lines 11-co1.17, line 38).

Re Claim 8: Papierniak further discloses the steps of compiling the variables into a commercial transaction report; and posting the report for viewing over the wide area network (figs. 15-15A)

Re Claim 9: Papierniak further discloses the steps of embedding the commercial data within a URL request directed at the second server (Col 12, lines 37-50)

(10) Response to Argument

Appellant argues that combining Papierniak and the Business Wire article (the examiner will use "Business Wire Article," in place of "Editors" for the sake of consistency with the Brief; but both names represent the same article) would not teach all the limitations of the claims and accordingly a prima facie case fails. In addition, Appellant argues that there is no suggestion within the cited art to implement client side commercial data mining by embedding script within the web pages while also using server side data mining systems such as Papierniak since combining systems would be redundant.

With regards to the argument that the references do not teach all the limitations of the claims, the examiner disagrees. Appellant argues that Papierniak does not disclose the steps of uploading a web page with data fields and mining code to the visitor computer and operating data mining code on the visitor computer to obtain technical and commercial data (Brief Page 5). On this point the Examiner agrees, as was stated in the Grounds of Rejection section above and in the previous Office Action.

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The examiner has used the Business Wire article for these limitations and for this reason it appears Appellants argument that Papierniak does not disclose these features is moot.

Papierniak does however teach using server-provided and maintained data from a web page, including warehoused data that '*is refined to represent products being sold through electronic commerce applications*, advertisements being seen by customers, *specific content viewed by customers*, etc, not URLs. (emphasis added; Column 4, lines 59-64.) This appears in contrast to Appellants argument the "general data warehouse," for storage of non-web specific data (Brief Page 7), and that the data stored there is not from a web page and does not contain commercial transactions. Papierniak thus explicitly states that the data is actually specific, about products being sold (commercial transactions), and not only from a web page (URL), but subsequently refined data of the customer on the web page. Again the argument that Papierniak does not teach the operation of data mining on the visitor computer is not germane at the present time because the Business Wire article was used for this teaching.

With regards to the Business Wire article, it appears that the Appellant concedes that the reference discloses the data mining code, uploaded to and operated on the visitor computer, which was the component lacking from the Papierniak reference (Brief Pages 8-9). However it Appellant argues that Business Wire does not disclose monitoring the 'commerce transaction activity.' Notwithstanding the fact that the Examiner feels the Papierniak reference has been shown, above, to include this limitation (Column 4, lines 59-64), the examiner feels that Business Wire also discloses

the tracking of e-commerce (See page 2, 'This is what every company wants. We provide information to help executives grow their business through *intelligent e-commerce strategies*. There is no other source for this kind of insight." Emphasis added).

It is of the examiners opinion then that all the limitations of the independent claims are found in either the Papierniak or Business Wire reference as previously cited.

As noted previously, the Appellant next alleges that there suggestion or motivation within the cited art to implement client side commercial data mining by embedding script within the web pages while also using server side data mining systems such as Papierniak. However, the Federal Circuit has stated that 'Although our predecessor court was the first to articulate, the motivation-suggestion-teaching test, a related test - the "analogous art" test - has long been part of the primary Graham analysis articulated by the Supreme Court. (See *Dann*, 425 U.S. at 227-29; *Graham*, 383 U.S. at 35.2). The analogous-art test requires that the Board show that a reference is either in the field of the applicant's endeavor or is reasonably pertinent to the problem with which the inventor was concerned in order to rely on that reference as a basis for rejection. In *re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992). References are selected as being reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art. *Id.* ("[I]t is necessary to consider 'the reality of the circumstances,'-in other words, common sense - in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor." (quoting *In re Wood*, 599 F.2d 1032, 1036 (C.C.P.A. 1979))).

In this case both references are concerned with gleaning information from customer interaction with a web page through data mining activity. The difference lies again in the client side versus server side argument. Therefore the examiner submits that the Business Wire reference is, at least, pertinent to the problem with which the inventor was concerned. It is also submitted that both references are within the field of the Applicants endeavor, namely the real time reporting of commerce activity via data mining, and therefore the references pass the analogous art test.

Regarding Appellants argument that the suggestion or motivation come from within the cited art; it has been found that "KSR forecloses Appellant's argument that a specific teaching is required for a finding of obviousness. KSR, 127 S.Ct at 1741, 82 USPQ2d at 1396. The Examiner submits that each of the elements of the cited references combined by the examiner performs the same function when combined as it does in the prior art. Thus, such a combination would have yielded predictable results. See Sakraida, 425 U.S. at 282, 189 USPQ at 453. The examiner also finds that one of skill in the art would have been able at the time of invention to combine the elements relied upon from Papierniak and thus under KSR they would have been obvious to combine.

Claims 1-9 recite combinations which only unite old elements with no change in their respective functions and yield predictable results. Thus, it is submitted that the claimed subject matter likely would have been obvious, at the time of invention, under KSR.

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Because the references recite each and every limitation of the claims, and combining the claimed subject matter would have been obvious under KSR, it is respectfully submitted that the rejection is proper.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Tim Harbeck



Conferees:

Jay Kramer



Vincent Millin



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